

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. Interview Summary

Applicants thank Examiner Farhan Syed and the Examiner's supervisor for the courtesies extended to Applicants' representative during the September 14, 2006 telephone interview. During the interview, Applicants' representative brought to the Examiner's attention that the present office action has been improperly made final. Applicants' representative discussed the provisions of MPEP § 706.07(a) as the basis for the impropriety. The Examiner and the Examiner's supervisor agreed that the office action had been improperly made final and further agreed to withdraw the finality upon submission of the present response.

II. 35 U.S.C. § 101

The Examiner has rejected claims 16-18 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

The Examiner has rejected this claim stating:

Claims 16-18 are rejected under 35 U.S.C. 101 because the claimed is directed to non-statutory subject matter. The claimed invention does not procedure a useful, concrete, and tangible result. Claims 16-18 describes a computer program product in a computer readable medium for accessing a database. The claims describe a computer readable medium, where in the specifications, is a form of a signal bearing media using communication links such as a radio frequency and light wave transmissions. Such types of communication links are not patentable as they are a natural occurring phenomenon. Correction is required.

Office Action dated February 24, 2006, pp. 3-4.

Section 101 of Title 35 U.S.C. sets forth the subject matter that can be patented:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

"[N]o patent is available for a discovery, however useful, novel, and nonobvious, unless it falls within one of the express categories of patentable subject matter of 35 U.S.C. § 101." *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 483, 181 USPQ 673,679 (1974). The statutory categories of § 101 define

eligible (patentable or statutory) subject matter, i.e., subject matter that can be patented. The listed statutory categories of invention are “process, machine, manufacture, or composition of matter.”

Claim 16 recites:

A computer program product in a computer readable medium for accessing a database containing text message for a plurality of cultural contexts, the computer program product comprising:

first instructions for receiving a request from a client to set a cultural context from the plurality of cultural contexts for the database; and

second instructions, responsive to receiving queries from the client, for processing the queries using the locale to select a text message in an appropriate cultural context without requiring the queries from the client to include the cultural context.

In the present case, claim 16 clearly and unquestionably recites a “product,” an article of manufacture, embodied in a tangible computer usable medium, implementing the method of claim 1. Section 100(b) of Title 35 U.S.C. defines “process” to mean, “process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” The definition of “process” to mean “process, art or method” makes it clear that the terms are synonymous. *See*, S. Rep. No. 1979, reprinted in 1952 U.S. Code Cong. & Admin. News at 2409-10. The Office cannot creatively redefine the claimed invention to be something other than what is explicitly recited in the claim for the sole purpose of rejecting the claim, and in this case, claim 1 recites a method. Therefore, the invention of claim 1 falls within the statutory categories of patentable subject matter because the claim recites a method. Therefore, claim 16 which claims a product implementing the method of claim 1 is also directed to statutory subject matter under 35 U.S.C. § 101.

Furthermore, the invention of claim 16 produces useful and tangible results with well known practical applications in the pertinent industry. Claim 16 recites “second instructions, responsive to receiving queries from the client, for processing the queries using the locale to select a text message in an appropriate cultural context without requiring the queries from the client to include the cultural context.” A query that uses the cultural context without including the cultural context is a less complex query.

The present invention provides a method to support NLS by minimizing the number of explicit NLS conditions required on a given query or related queries; and by reducing the complexity of these queries for multiple languages or locales.

Specification, p. 5, ll. 12-16.

The fact that a less complex query executes faster than a more complex query is well known in the pertinent art of databases. Due to the well recognized importance of fast executing queries because they improve, among other things, the database performance, database technologies today incorporate a variety of techniques to reduce query complexity and increase speed of query execution. Therefore, the

invention of claim 16, which teaches a less complex query, produces a useful result, quantifiable in the time saved in query execution, and tangible in the increased number of queries that can be processed because of the invention in the same amount of time.

Furthermore, the invention of claim 16 is patentable in view of new guidelines covering patentability of claims directed to a process in a computer readable medium. The USPTO Guideline for evaluating computer-readable medium encoded with functional descriptive material, such as a computer program, expressly states that a claim to such computer-readable medium when so encoded is statutory subject matter. USPTO, *Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility* (26 Oct. 2005) (hereinafter “Guideline”). The Guideline provides, in relevant part:

“[A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.”

Id., p. 52.

The Guideline further provides:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O’Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

...
These interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101. Public comment is sought for further evaluation of this question.

Id., pp. 55-56.

Claim 16 is directed to a computer program product in a computer readable medium. As the Guideline provides, “a computer readable medium with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized” is statutory. Because claim 16 recites a computer program product in a computer readable medium, along with the other recited steps, claim 16 does describe a data structure that defines structural and functional interrelationships between the data structure and the computer software and hardware components, which permit the data structure’s functionality to be realized. Thus, claim 16 is patentable subject matter under 35 U.S.C. § 101, as explained under the Guideline.

The claim recites a “computer readable medium” in which a signal is embedded. Claim 16 claims functional descriptive material encoded on a computer readable medium and does not claim

signals encoded with functional descriptive material. For this additional reason, claim 16 falls under allowable statutory matter under 35 U.S.C. § 101.

Claim 16 comprises statutory subject matter because the claim is directed towards the medium, and not to the radio frequency or the light wave signals that may inherently be used in such media technologies. The use of radio frequency or light wave as a method of encoding or recording the computer program onto such medium does not render the medium itself nonstatutory. Even in the case of a CD-ROM, a laser form of light wave is used for accomplishing the encoding/recording of the information onto the CD-ROM, yet the CD-ROM remains a well-accepted computer readable medium. Encoding the air or glass fiber medium with radio frequency or light wave similarly cannot render the air or glass fiber medium nonstatutory under § 101.

Thus, based on the MPEP and applicable case law, claim 16 is statutory under 35 U.S.C. § 101. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 16-18 under 35 U.S.C. § 101.

Above reasoning was presented in response to a similar rejection of these claims in a previous office action. The Examiner responds to this reasoning as follows:

Applicant's arguments filed 26 May 2006 have been fully considered but they are not persuasive. Claims 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim clearly recite a "computer readable medium", which may "take the form of a signal bearing media using communication links such as a radio frequency and light wave transmissions" (Applicant's specification, page 25). The use of radio frequency and light wave transmissions are illustrations of using the form of energy and are not tangible, and cannot tangibly embody a computer program or process since a computer cannot understand/realize (i.e. execute) the computer program or process when embodied on a data signal. Computer program or processes are only realized within the computer when stored in a memory or storage element (such as RAM or ROM). Therefore, a signal bearing media does not meet the "useful, concrete, and tangible" requirement as set forth in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02, and hence claims 16-18 are non statutory under 35 U.S.C. 101. For a further explanation of the use of signals and carrier waves, the Examiner refers to the Interim Guidelines accessible online at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.0df.

Office Action dated August 23, 2006, pp. 2-3.

The Examiner has not expressly rejected claims 16-18 under 35 U.S.C. § 101 in the present office action. Presently, the Examiner has only found the reasoning provided in the previous response non-persuasive. Present response anticipates that the Examiner intended to reject claims 16-18 under 35 U.S.C. § 101 in the present office action as well. The Examiner incorrectly connects any use of radio frequency and light wave transmissions to the claims in rejecting Applicants' reasoning. The Examiner's

basis for rejecting the reasoning, in essence, is that because radio frequency and light wave transmissions are not tangible, a computer program embodied in such signals are also not tangible and therefore non-statutory subject matter.

However, the Examiner maintains a flawed understanding of the claim features and corresponding sections of the specification. As reasoned above, again, the claim recites a computer readable medium and not a computer readable signal. The specification provides:

Examples of computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and transmission-type media, such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions.

Specification, p. 25, ll. 14-20.

This section of the specification provides that radio frequency and light waves are transmission forms that are used in a medium that corresponds with the computer readable medium recited in claim 16. Virtually all computer readable media, including the indisputably acceptable floppy disks and CD-ROMs use some form of electro-magnetic signal for the medium to be readable by a computer. A floppy disk uses magnetic signals, and a CD-ROM uses a light wave in the form of a laser in order to be readable by a computer. Such signals are not expressly stated with respect to the floppy disk and CD-ROM media but are nonetheless used in those media without making those media non-statutory. Likewise, a stated use of electromagnetic signals, such as radio frequency and light wave transmissions, in a computer readable medium cannot make the medium non-statutory. Accordingly, recitation in claim 16 of a computer readable medium that uses radio frequency and light wave signals does not render claim 16 non-statutory.

The Examiner cites to the Interim Guidelines (referred to, and cited as “The Guideline” above) in support of the rejection, but fails to recognize that the reasoning in the previous response relies on the very same Interim Guidelines and the Interim Guideline in fact supports that reasoning. Relevant sections of The Guideline are quoted above to demonstrate why claim 16 comprises statutory subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 16-18 under 35 U.S.C. § 101.

III. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1-20 under 35 U.S.C. § 102 as being anticipated by non-patent literature publication, Google Language Tools, published August 13, 2002, (hereinafter, “Google”). This rejection is respectfully traversed.

III.A. As to Claims 1-8, 11-13, 16-17, and 19

The Examiner has rejected claim 1 stating:

As per claims 1, 9, 11, 14, 16, 18, 19, and 20, Google teaches a method in a data processing system for accessing a database containing text message for a plurality of cultural contexts, the method comprising (i.e. The Google language tool is a data processing system for accessing a database, because an ordinary person skilled in the art understands that Google is a popular search engine on the World Wide Web.) (Page 1): receiving a request from a client to set a cultural context from the plurality of cultural contexts for the database (i.e. On page 1, the search page written in: <any language> clearly illustrates that a client requests a cultural context, which is selecting a language from a plurality of cultural contexts, which are many languages contained in the drop-down field. Furthermore, because the Google site is a search engine, an ordinary person skilled in the art understands that a database resides on the back-end that services the Google language tools site.)(Page `); and responsive to receiving queries from the client (Page ` indicates that a text field contained in Search for: clearly indicates that this page is responsive to receiving queries from the client)(Page 1), processing the queries using the locale to select a text message in an appropriate cultural context (Page 1 clearly indicates that the locale is the result of the client selecting pages located in <any country>, contained in the search for text field would be the targeted text message, and the query is processed when a client selects the Google Search button.)(Page1) without requiring the queries from the client to include the cultural context (i.e. “Tip: If you typically search only pages in a specific language or languages, you can save this as your default search behavior on the Preference page.” The preceding text clearly indicates that a client has an ability to pre-select the cultural context and perform queries.)(Page 1).

Office Action dated August 23, 2006, pp. 3-4.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1 recites:

A method in a data processing system for accessing a database containing text message for a plurality of cultural contexts, the method comprising:

receiving a request from a client to set a cultural context from the plurality of cultural contexts for the database; and

responsive to receiving queries from the client, processing the queries using the locale to select a text message in an appropriate cultural context without requiring the queries from the client to include the cultural context.

Contrary to the Examiner's assertion, *Google* fails to show the claimed feature, "receiving a request from a client to set a cultural context from the plurality of cultural contexts for the database," "select a text message in an appropriate cultural context," and "without requiring the queries from the client to include the cultural context," as claimed. Each of these features is not taught by the reference because the reference does not teach cultural context as recited in each of these claim features. The entire relevant section of the reference cited by the Examiner is as follows:

Search Specific Languages or Countries

Search only pages written in a specific language

Search only pages from a specific country

Search for:

Google Search

If you typically search only pages in a specific language or languages, you can save this as your default search behavior on the Preferences page.

Translate (BETA)

Translate text

From German to English

To German

or

Translate a webpage

http://

From German to English

To German

Use the Google Interface in Your Language

On the Google homepage, messages and buttons to display in your selected language via our Preferences page. Google currently offers the following interface languages:

- | | | | | |
|-------------------------|-------------------------|--------------|--------------|--------------|
| • Afrikaans | • Catalan | • Czech | • Danish | • Dutch |
| • Albanian | • Chinese (Simplified) | • English | • Finnish | • French |
| • Armenian | • Chinese (Traditional) | • Esperanto | • Galician | • German |
| • Arabic | • Croatian | • Estonian | • Hebrew | • Hindi |
| • Azerbaijani | • Czech | • Finnish | • Hungarian | • Indonesian |
| • Basque | • Danish | • French | • Italian | • Japanese |
| • Bengali | • Dutch | • German | • Korean | • Latvian |
| • Berber | • English | • Greek | • Lithuanian | • Macedonian |
| • Bhojpuri | • Finnish | • Hebrew | • Latvian | • Maltese |
| • Bosnian | • French | • Hindi | • Lithuanian | • Norwegian |
| • Bulgarian | • Galician | • Hungarian | • Latvian | • Polish |
| • Catalan | • German | • Italian | • Lithuanian | • Portuguese |
| • Chinese (Simplified) | • Greek | • Japanese | • Lithuanian | • Romanian |
| • Chinese (Traditional) | • Hebrew | • Korean | • Lithuanian | • Russian |
| • Croatian | • Hindi | • Latvian | • Lithuanian | • Serbian |
| • Czech | • Hungarian | • Lithuanian | • Lithuanian | • Slovak |
| • Danish | • Indonesian | • Lithuanian | • Lithuanian | • Slovenian |

Google, p. 1.

The quoted section is a search configuration webpage on *Google's* website. The webpage allows a user to select a preferred language to indicate the user's preference for searching only pages in that specific language. The webpage also appears to provide a translation service for translating a result of a search into the language preferred by the user. The reference provides very limited information for correctly interpreting the working and scope of the webpage beyond the description provided here.

The Examiner incorrectly assumes that the language selection in *Google* is the cultural context as claimed. The claim recites “cultural context,” a term that Applicants define in the specification as:

a cultural context including a country, time zone, age, or date may be used in place of a language.

Specification, p. 24, ll. 21-22.

By definition then, language and “cultural context” are separate concepts. Even if, *arguendo*, a fictitious reference discloses a method similar to the method of claim 1 but with respect to language, this reference will have failed to disclose the method with respect to a cultural context. This is because, at best, language can be one of the components of a cultural context, as distinct from language being one and the same as the cultural context. As is evident from the specification, the cultural context includes numerous components, of which language may be one component. But disclosure of one component does not disclose the whole cultural context. Language may be one component of the cultural context; language is not one cultural context, and therefore use of language cannot anticipate use of cultural context. *Google* only discloses a multilingual system offering language selection capabilities and none of the cultural context elements as defined. *Google* offers no other factors in combination with the language that may be treated as being similar to the cultural context as claimed. For this reason, *Google* does not teach “cultural context” as recited in claim 1.

Because *Google* fails to disclose cultural context as recited in claim 1, *Google* does not teach the features, “receiving a request from a client to set a cultural context from the plurality of cultural contexts for the database,” “select a text message in an appropriate cultural context,” and “without requiring the queries from the client to include the cultural context,” of claim 1. Consequently, *Google* anticipates the invention of claim 1. For the same reasons, *Google* also does not anticipate claims 11, 16, and 19 because these claims recite features similar to those recited in claim 1. Additionally, at least by virtue of their dependence from claims 1, 11, and 16 respectively, *Google* also does not anticipate claims 2-8, 12-13, and 17. Therefore, Applicants have overcome the Examiner’s rejection of claims 1-8, 11-13, 16-17, and 19 under 35 U.S.C. § 102(b).

Claims dependent from claims 1, 11, and 16 recite additional features not taught by *Google*. For example, claim 5 recites:

The method of claim 4, wherein the cultural context ID is fixed based on the request.

Google does not teach, “cultural context ID is fixed based on the request,” feature of claim 5. *Google* does not teach this feature of claim 5 for at least two reasons. Firstly, because *Google* does not teach “cultural context” as described above, *Google* cannot teach a feature involving identification (ID) of

a cultural context. Secondly, *Google* cannot teach that the untaught cultural context ID be fixed as claimed. For these additional reasons, *Google* does not anticipate claim 5 under 35 U.S.C. § 102(b)

III.B. As to claims 9-10, 14-15, 18, and 20

The Examiner has not pointed to anything in the reference that specifically teaches the features of claim 9 and other similar claims in this group. The features of claim 9 are not the same as the features of claim 1, yet the Examiner has rejected claim 9 on the same basis as cited for the rejection of claim 1. In the remainder of the present office action, the Examiner has provided specific rejections of the claims that depend from the independent claims 1, 11, and 16. However, no specific rejections of the claims that depend from the independent claims 9 and 14 are provided. Examiner's rejection of claims 1 and 9 is quoted above, and is not quoted here again for the sake of brevity. Following analysis distinguishes claims 9-10, 14-15, 18, and 20 from *Google* without the benefit of specific citations in the office action.

Claim 9 recites:

A method in a data processing system for accessing a database containing text messages, the method comprising:
receiving a condition from a user to form a fixed condition;
maintaining the condition for the user with respect to queries to the database; and
responsive to receiving a query from the user after receipt of the request, processing the query using the fixed condition to select a text message without requiring the query to include the fixed condition.

As described in section III.A above, the Examiner's interpretation of *Google*'s disclosure is incorrect. Contrary to the Examiner's assertion, *Google* fails to show the claimed feature, "without requiring the queries from the client to include the fixed condition" as claimed. The relevant sections from *Google* that are cited by the Examiner have been quoted and described in section III.A above.

The reference only teaches that a user can save a preferred language as a default search behavior. This teaching, however, does not mean that a search query will not require a language parameter at all. Saving a preference only means that the user will not have to select the language each time the user executes a search. However, the reference does not teach that when the search query is constructed, the query does not incorporate a preferred language by default. As a result, the reference fails to teach that a query from a client will not include a language.

With this understanding, all that the reference teaches is that a condition for a search may be fixed. The reference, however, does not teach that the resulting search query does not include the fixed condition. The feature of claim 9 recites, "without requiring the queries from the client to include the fixed condition." Therefore, the reference does not teach the claim feature as recited. Consequently, *Google* anticipates the invention of claim 9. For the same reasons, *Google* also does not anticipate claims

14, 18, and 20 because these claims recite features similar to those recited in claim 9. Additionally, by virtue of their dependence from claims 9 and 14 respectively, *Google* also does not anticipate claims 10 and 15. Therefore, Applicants have overcome the Examiner's rejection of claims 9-10, 14-15, 18, and 20 under 35 U.S.C. § 102(b).

IV. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being obvious over *Google* in view of *Conrad et al.*, Computerized system and process for interactively managing a distributed database system, United States Patent 5,539,870 (issued, July 23, 1996) (hereinafter, "*Conrad*"). This rejection is respectfully traversed.

The Examiner has rejected claim 4 stating:

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Google Language Tool in view of Conrad et al (U.S. Patent No. 5,539,870 and known hereinafter as Conrad).

As per claim 4, Google does not explicitly teach a method wherein multi-cultural text is stored in separate rows with a message ID and a cultural context ID.

Conrad teaches a method wherein multi-cultural text is stored in separate rows with a message ID and a cultural context ID (i.e. "*For example, the table contains entries to define a relationship of TABLE 98 to VIEW 99 and TABLE 100 to AUTHS 101 by having two separate rows having TABLE as the object type with corresponding related object type entries of "VIEW" and AUTHS work". There is further repetition for all of the applicable qualifiers to each object-related object pair.*" The preceding text clearly indicates that a multi-cultural text is a table entry and 'View' and 'Auths work' are message ID and a cultural context ID, respectively.)(column 8, lines 24-30).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Google with the teachings of Conrad to a method wherein multi-cultural text is stored in separate rows with a message ID and a cultural context ID with the motivation to manage all of the systems in a distributed database system. (Conrad, column 2, lines 27).

Office Action dated August 23, 2006, pp. 6-7.

Claim 4 recites:

The method of claim 3, wherein multi-cultural text is stored in separate rows with a message ID and a cultural context ID.

IV.A. The Proposed Combination Does Not Teach or Suggest all of the Features of Claim 4

The Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination does not teach all of the features of claim 4. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All

limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Because *Google* does not anticipate claim 1 as described in section III.A above, *Google* also does not teach all features of claim 4, which depends from claim 1. Particularly, Applicants have shown that *Google* does not teach at least two features of claim 1, and therefore at least two features of claim 4. These features are, “without requiring the queries from the client to include the cultural context,” and “cultural context” as defined. *Conrad* does not cure these deficiencies in *Google* and therefore cannot make obvious the invention of claim 4.

Conrad’s entire disclosure fails to teach or suggest use of cultural context as claimed. *Conrad* is concerned with providing interactive graphical display of object relationships and instances by means of a table driven process. *Google* is concerned with allowing a user to set a preferred language for searches. The claimed invention is concerned with processing database queries in a cultural context, without including the cultural context in the query, making the queries less complex.

The purpose, method, and systems as disclosed in *Conrad* are inconsistent with those disclosed in *Google* as well as those disclosed in the present invention. *Conrad* does not cure *Google*’s shortcoming in teaching the invention of claim 1, and therefore, considered together with *Google* cannot make obvious the invention of claim 4. Therefore, the Examiner has failed to make a *prima facie* case of obviousness against claim 4 under 35 U.S.C. § 103.

IV.B. The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against features of claim 4 because the Examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the Examiner has only stated a proposed advantage to combining the references. However, an advantage proposed by the Examiner is not a teaching, suggestion, or motivation based on the prior art. To constitute a proper teaching, suggestion, or motivation, the Examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the

combination, even if he or she recognized the advantage, and so no teaching, suggestion, or motivation exists to combine the references.

In the case at hand, the Examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. Instead, the Examiner points to features in the cited reference that give the Examiner motivation to combine them, rather than pointing to the motivation in the prior art. The Examiner states,

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Google with the teachings of Conrad to a method wherein multi-cultural text is stored in separate rows with a message ID and a cultural context ID with the motivation to manage all of the systems in a distributed database system. (Conrad, column 2, lines 27).

Office Action dated February 24, 2006, pp. 6-7.

However, the proposed motivation does not actually exist because *Google's* method discloses no desirability or need for providing a display of table driven object relationship as relates to distributed database systems. *Google* is concerned with allowing a user to set a preference without regard to the nature of the database system that the user searches. *Conrad* discloses a table with rows indicating table-to-view or table-to-other-database-object-types in a distributed database system. The Examiner cites the following section from *Conrad* in support of the rejection:

For example, the table contains entries to define a relationship of TABLE 98 to VIEW 99 and TABLE 100 to AUTHS 101 by having two separate rows having TABLE as the object type with corresponding related object type entries of "VIEW" and "AUTHS work". There is further repetition for all of the applicable qualifiers to each object-related object pair.

Conrad, col. 8, ll. 24-30.

In the cited section, or the entire disclosure, *Conrad* discloses nothing with respect to a user preference setting stored in *Conrad's* table in separate rows, which could be usable in *Google's* system. *Google* appears to provide a complete system and method for system locale configuration, and does not appear deficient in supporting that function. Because *Google* does not appear to be lacking in this capability, *Google's* existing disclosure vitiates any putative need for *Conrad's* teachings. For these reasons, the Examiner's statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 4.

IV.C. No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, a *prima facie* obviousness rejection against features of claim 4, has not been made because no proper teaching or suggestion to combine the references exists in the references. A *prima*

facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). No such teaching or suggestion is present in the cited references and the Examiner has not pointed out any teaching or suggestion that is based on the prior art.

The references themselves do not suggest the proposed advantage. In the present case, *Google* has neither a need, nor an advantage in providing tools for interactive management of distributed database systems, while configuring a single computer's locale. *Google* pertains to a user's computer where a user is allowed to select a language preference. *Conrad*, on the other hand, discloses a distributed database environment where a detailed view of database object interaction is facilitated by *Conrad*'s invention. Therefore, no need actually exists in *Google*, to combine, or provide motivation to combine *Conrad* with *Google* in order to allow a user to set a language preference. Likewise, no need exists in *Conrad* to use *Google*'s system to provide a detailed view of database object interactions in distributed database environments. Accordingly, the Examiner has not actually stated a teaching or suggestion based on the references to combine the references. Instead, the Examiner has only put forth a hypothetical advantage of combining the references based on the Examiner's opinion rather than on a pre-existing teaching, suggestion, or motivation found in the references themselves. Thus, the Examiner has failed to state a *prima facie* obviousness rejection against claim 4.

IV.D. *Google* and *Conrad* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 4, because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances, in other words, common sense, in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Google* shows a system for allowing a user to set a language preference. *Google* has no need to address the problem of providing a detailed view of distributed database object interactions for the reasons explained in section IV.A above. On the other hand, *Conrad* shows a system for displaying detailed views of distributed database object interactions. *Conrad* represents a complete solution for fashioning such a system. *Conrad* has no disclosure touching upon language preference setting aspects of *Google*. Furthermore, neither reference is in the area of endeavor of the claimed

invention – processing queries for retrieving data from a database in a cultural context, without including the cultural context in the queries.

Thus, the references address distinct problems that are unrelated to each other. Because the references address distinct problems, and each of these problems are further distinct from the problem of the claimed invention, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the Examiner. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 4.

IV.E. Summary of Why the Examiner Has Failed to State a *Prima Facie* Obviousness Rejection Against Claim 4

In general, the Examiner appears to proceed from the false assumption that just because individual elements of a claimed invention can be found in two or more references, combining the references would automatically render the claimed invention obvious to one of ordinary skill. In fact, that vast bulk of patentable inventions is derived from combinations of elements that can be found in the prior art.

In the case at hand, the Examiner has failed to state a *prima facie* obviousness rejection for the following reasons: The proposed combination does not teach or suggest all of the features of claim 4; the Examiner has not stated a proper teaching, suggestion or motivation to combine the references; no teaching, suggestion, or motivation exists to combine the references; and *Google* and *Conrad* would not be combined by one of ordinary skill in the art because they address different problems. Therefore, the rejection against claim 4 under 35 U.S.C. § 103(a) has been overcome.

V. Conclusion

It is respectfully urged that the subject application is patentable over *Google*, in view of *Conrad*, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: November 21, 2006

Respectfully submitted,

/Rakesh Garg/
Rakesh Garg
Reg. No. 57,434
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Agent for Applicant